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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,692	03/03/2004	Yuichi Toriumi	118938	2283
25944	7590	08/17/2007		
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER TRAN, MY CHAU T	
			ART UNIT 2629	PAPER NUMBER
			MAIL DATE 08/17/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/790,692	Applicant(s) TORIUMI ET AL.	
	Examiner MY-CHAU T. TRAN	Art Unit 2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-28 is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/25/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Application and Claims Status

1. Applicant's amendment and response filed 07/25/2007 are acknowledged and entered.

The specification is amended to correct a typographical error.

2. Claims 1-28 were pending. No claims were amended, added and/or cancelled.

Therefore, claims 1-28 are currently pending and are under consideration in this Office Action.

Maintained Rejection(s)

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 5 of copending Application No. 10/833,996

(US Patent Application Publication US 2005/0001803 A1; Now refers as Morita et al.).

Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant claimed device of claim 1 and the claimed device of Morita et al. have similar structural features.

Specifically, the claimed device of Morita et al. comprises a gray-scale bus (refers to instant claimed a gray-scale bus), a capture start timing setting register (refers to instant claimed a capture start timing setting register), a capture instruction signal generation circuit that generates signals set by the capture start timing setting register (refers to instant claimed a shift start signal generation circuit), a first shift register which includes a plurality of flip-flops of claim 5 (refers to instant claimed a shift register), a first data latch (refers to instant claimed a data latch), and a first driver circuit (refers to instant claimed a data line driver circuit).

That is the claimed device of the instant application is generic to the claimed device of copending Application No. 10/833,996 or in other word claim 1 of the instant application is anticipated by claims 1 and 5 of copending Application No. 10/833,996. Accordingly, the examined claim would be obvious over the claims of copending Application No. 10/833,996.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

5. Applicant's arguments directed to the above nonstatutory obviousness-type double patenting rejection were considered but they are not persuasive for the following reasons.

[1] Applicant contends that '*the provisional obviousness-type double patenting rejection should be withdrawn*' because '*the two-way test for obviousness should be applied to the claims*

of the pending application because the pending application was filed before Morita, and the delay in processing the pending application is due entirely to administrative delay within the Patent Office'. Additionally, applicant asserted that *'Claims 1 and 5 of Morita are patentably distinct from claim 1 of the pending application because claims 1 and 5 of Morita are broader as they include several features not recited in claim 1 of the pending application'*. Thus, the nonstatutory obviousness-type double patenting rejection should be withdrawn.

This is not found persuasive for the following reasons:

[1] The examiner respectfully disagrees. It is the examiner's position that the nonstatutory obviousness-type double patenting rejection should be maintained.

First, Claims 1 and 5 Morita et al. (i.e. copending Application No. 10/833,996) is **narrower** than the instant claim 1 since claims 1 and 5 of Morita et al. recited additional features that are not recited in instant claim 1. The comprising language of the instant claim 1 does not exclude the additional features recited in claims 1 and 5 of Morita et al. See MPEP § 2111.03, which states:

The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps.

Accordingly, claims 1 and 5 of Morita et al. are not patentably distinct from claim 1 of the instant application.

Second, since claim 1 is not patentably distinct from claims 1 and 5 of Morita et al. these claims could have been filed in a single application, and as a result the issue regard administrative delay is irrelevant. See MPEP § 804(B)(1)(b), which states:

A two-way test is to be applied only when the applicant could not have filed the claims in a single application and there is administrative delay. In re Berg, 46

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USPQ2d 1226 (Fed. Cir. 1998) ("The two-way exception can only apply when the applicant could not avoid separate filings, and even then, only if the PTO controlled the rates of prosecution to cause the later filed species claims to issue before the claims for a genus in an earlier application . . . In Berg's case, the two applications could have been filed as one, so it is irrelevant to our disposition who actually controlled the respective rates of prosecution."). In the absence of administrative delay, a one-way test is appropriate.

Consequently, a one-way test is appropriate in regard to the instant application and the copending Application No. 10/833,996.

Therefore, the examined claim 1 would be obvious over the claims of copending Application No. 10/833,996, and the rejection is maintained.

Allowable Subject Matter

6. Claims 2-28 are allowed.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MY-CHAU T. TRAN whose telephone number is 571-272-0810. The examiner can normally be reached on Monday: 8:00-2:30; Tuesday-Thursday: 7:30-5:00; Friday: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard A. Hjerpe can be reached on 571-272-7691. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/My-Chau T. Tran/
Patent Examiner
Art Unit 2629
August 15, 2007



RICHARD HJERPE
SUPERVISORY PATENT EXAMINER
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